



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

JACOBS, et al.

Serial No.: 10/645,886

Filed: August 20, 2003

Art Unit: 3622

Examiner: R. Alvarez

Docket No. 000373D3

For: **E-MAIL SOFTWARE AND METHOD AND SYSTEM FOR DISTRIBUTING ADVERTISEMENTS TO CLIENT DEVICES THAT HAVE SUCH E-MAIL SOFTWARE INSTALLED THEREON**

CERTIFICATION UNDER 37 CFR § 1.8

I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, Box 1450, Alexandria, VA. 22313-1450

7/20/04

Signature

Tami M. Procopio

MAIL STOP AMENDMENT
Commissioner for Patents
P. O. Box 1450
Alexandria, VA. 22313-1450

Sir:

AMENDMENT AND REQUEST FOR RECONSIDERATION

In response to the Office Action dated April 29, 2004, please reconsider the rejection of the pending claims for reasons given below. In addition, please amend the application as follows:

IN THE SPECIFICATION

Please amend the specification at page 1 by inserting the following section immediately before line 16;

CROSS-REFERENCE TO RELATED APPLICATIONS

The following co-pending, commonly-assigned identically-titled patent applications contain subject matter related to the subject matter of this application:

US Patent Application SN 09/609,123, filed 6/30/00;
US Patent Application SN 09/668,331, filed 9/22/00;
US Patent Application SN 09/668,511, filed 9/22/00;
US Patent Application SN 09/668,514, filed 9/22/00;
US Patent Application SN 09/668,515, filed 9/22/00;
US Patent Application SN 09/668,553, filed 9/22/00;
US Patent Application SN 09/668,595, filed 9/22/00;
US Patent Application SN 09/668,599, filed 9/22/00;
US Patent Application SN 09/668,600, filed 9/22/00;
US Patent Application SN 09/668,603, filed 9/22/00;
US Patent Application SN 09/668,631, filed 9/22/00;
US Patent Application SN 09/668,632, filed 9/22/00;
US Patent Application SN 09/668,633, filed 9/22/00;
US Patent Application SN 09/679,038, filed 10/4/00;
US Patent Application SN 09/679,039, filed 10/4/00;
US Patent Application SN 09/679,040, filed 10/4/00;
US Patent Application SN 09/728,053, filed 12/1/00;
US Patent Application SN 09/728,065, filed 12/1/00;
US Patent Application SN 09/728,099, filed 12/1/00;
US Patent Application SN 09/728,110, filed 12/1/00;
US Patent Application SN 09/728,651, filed 12/1/00;
US Patent Application SN 09/728,693, filed 12/1/00;
US Patent Application SN 09/732,039, filed 12/7/00;
US Patent Application SN 09/732,158, filed 12/7/00; and
US Patent Application SN 09/732,352, filed 12/7/00.

REMARKS

The specification has been amended. Claims 1-19 remain in the application.

Claims 1-19 are provisionally rejected for obviousness-type double patenting over various claims of co-pending US Patent Application No. 09/679,039, US Patent Application No. 09/679,038, US Patent Application No. 09/728,693, US Patent Application No. 09/668,553, US Patent Application No. 09/668,331, US Patent Application No. 09/668,632, US Patent Application No. 09/668,515, US Patent Application No. 09/668,631, and US Patent Application No. 09/668,600. In view of the fact that prosecution is still ongoing in those applications, the applicants reserve response to this provisional rejection until all other issues of patentability are settled in these applications.

Claims 1-19 are rejected for obviousness over US Patent No. 5,848,397 ("Marsh") in view of US Patent 6,298,332 ("Montague"). That rejection is respectfully traversed for the following reasons.

Claim 1, which is representative of the rejected claims, is directed to software for use on a client device that is configured for communications with at least one remote source of advertisements via a communications network. The software includes an advertisement download function that downloads advertisements from the at least one remote source, during one or more advertisement download sessions, an advertisement storage function that stores the downloaded advertisements on a storage medium associated with the client device, and an advertisement display function that effects display of at least selected ones of the stored advertisements on a display associated with the client device. Claim 1 (and all of the rejected claims) further comprehends:

"an audit data transmit function that transmits one or more categories of the audit data to a prescribed server system, wherein:

the audit data transmit function generates a send audit data display window that requests the user's permission to transmit each category of the audit data to the prescribed server system; and

the audit data transmit function transmits only the category(ies) of the audit data for which the user has granted permission to transmit."

All of the functions recited in the rejected claims are functions of “software for use on a client device”. Although they may interact or operate co-operatively with devices, computers, servers, other than the “client device”, none of the claimed functions is part of, or for use on, any device other than the recited client device. In particular, none of the functions is part of or performed by a server.

Marsh discloses message (ad) presentation functions that are distributed between a client computer and a server system. The complete disclosure of Marsh’s system includes the subject matter of US Patent Application Serial No. 08/948,779 (now US Patent No. 6,014,502 of Moraes), incorporated by reference into Marsh at col. 2, lines 12-21. In Marsh’s system, advertisements are selected by, obtained by, and transferred by a mail server in a server system 104 that is “an electronic mail (e-mail) system which functions as an electronic post office.” See Marsh at col. 6, lines 15-17. The advertisements are downloaded by the e-mail server system to a client system in response to the client connecting to a mail server. See Moraes at col. 21, lines 3-6. According to Marsh at col. 16, lines 19-22, the advertisement download scheduler in the server system “controls the transfer of advertisements *from a Mail server M_n* to a client system 101.” (Applicants’ emphasis.) When the client system receives the downloaded ads, they are detected and stored by an advertisement display scheduler residing on a user computer. See Marsh at col. 3, lines 5-11. Both references omit disclosure of advertisements that are transferred by “software for use on a client device” from an “advertisement distribution server system”.

With respect to claims 1-19, the contention in the Office Action is that Marsh teaches software for use in a client device which includes “an advertisement download function that downloads advertisements from at least one remote source during one or more advertisement download sessions (see figure 4 item 601).” In fact FIG. 4 of Marsh only shows an example of a display terminal monitor displaying a banner advertisement 601. It does not show “an advertisement download function”, let alone an advertisement download function that is a component of “software for use on a client device.” Marsh’s description of FIG. 4 at column 7, lines 40 through column 8, line 30 does not describe how the banner advertisement 601 is brought to a client device. While these advertisements are scheduled for display by an advertisement display scheduler on a client device, the advertisement display scheduler does not download advertisements. Marsh altogether lacks “software for use on a client device” that comprises “an advertisement download function”. The only advertisement download function disclosed

by Marsh resides in an “advertisement download scheduler” that “is located at the server system 104.” As stated above, Marsh teaches that the “*server system*” includes the advertisement download scheduler which “determines when the advertisements are transferred to each user.” According to Marsh at col. 16, lines 19-22, the advertisement download scheduler in the server system “controls the transfer of advertisements from a Mail server M_n to a client system 101.” In contrast, the rejected claims explicitly recite that the “advertisement download function” is in “software for use on a client device”. Marsh does not disclose software for use on a client device with any function that “downloads advertisements”.

The further contention in the Office Action is that, since Marsh teaches sending statistical data to a server, Montague, in teaching the user-authorized transmission of vendor-supplied information, would have made obvious to a person of ordinary skill in the art at the time of the applicants’ invention the inclusion “in the system of Marsh the teaching of Montague of sending the data only in response to a user’s grant of permission to do so because such a modification would allow the users to have control of the data that is transmitted.”

As implicitly conceded in the Office Action, at the time the invention was made, the prior art did not teach a client device software with advertisement download, storage, and display functions including an audit data transmit function that transmits “one or more categories of the audit data to a prescribed server system” by generating “a send audit data display window that requests the user’s permission to transmit each category of the audit data to the prescribed server system” and then by transmitting “only the category(ies) of the audit data for which the user has granted permission to transmit.” See MPEP 2141.01 III. In fact, the only way which such an invention could be appreciated during examination is with reference to the applicants’ specification. However, hindsight reasoning which uses the applicant’s specification as a guide is expressly forbidden. See *In re Dembicza*k, 50 USPQ2d at 1617, (Fed. Cir. 1999).

The only support given for the proposed modification of Marsh by addition of the audit display window that requests the user’s permission and then sending only when the user gives permission is the teaching of Montague that a user may selectively authorize the sending of vendor data obtained from a CDE tag to a vendor. Marsh addresses ad display scheduling and uses statistical data to enhance display and download scheduling. Montague addresses vendor/consumer relationships. Neither

problem has anything to do with the problems solved by the invention of the rejected claims.

Two problems are addressed by the invention of the rejected claims. First is the problem of fraudulently-placed ads, which can be detected by statistical analysis. See the specification at page 65, line 29 through page 67, line 6. As the specification makes clear, the data necessary to the analysis is ad-related statistical data such as that illustrated in the tables on pages 67 and 68 of the specification, which must be gathered from users. But this gives rise to the problem of protecting the user's privacy in the collection of such data. See the specification at page 68, line 2 through page 69, line 12:

"One of the issues which the software provider must be very cognizant of is the protection of the user's privacy, i.e., the user generally does not want to receive ads based on information that the user unknowingly submitted to the software provider. There is an extremely vocal and paranoid subset of the user community, who object to practically all forms of information gathering, even the most benign." Specification, page 68, lines 2-6.

The solution is to explicitly ask for the user's permission to send the audit data categories, and then to send the categories only when the user grants that permission. This solution is implemented in the functions that are explicitly recited in claim 1, and that limit all of the rejected claims.

Marsh does not teach or suggest any action at all that requests permission to send audit data categories and then sends audit data categories only when permission is granted. The sending of audit data categories solves problems that are different than the problems solved by the invention of the rejected claims. In this regard, Marsh's message presentation apparatus logs ad statistics and reports them back to a server system to schedule ad downloading and "for use in billing vendors." Marsh, column 4, lines 38-40.

Further, audit data categories are not required by the invention of the rejected claims for billing purposes as in Marsh. Instead, ad downloading initiates the billing event in the invention described and claimed in this application. That is to say, the primary purpose of the invention "is to distribute paid advertisements". See the definition of "advertisement" in the specification of this application at page 12. The audit data categories (such as ad-related statistical data) are utilized for proving that paid-for ads are actually viewed.

Note that this argument is not directed to introducing certain features of the applicants' invention that are not recited in the claims (protection of user's privacy).

Instead, the applicants simply contend that because the nature of the problem addressed by the claims is altogether different than those faced by Marsh and Montague, there is no motivation to modify Marsh by Montague in the manner proposed by the examiner.

In short, there was no suggestion at the time the invention was made to modify Marsh by adding an audit-data transmission function that requests permission to send audit data categories and then sends only such categories as to which permission is granted.

Moreover, if audit data categories were sent only with a user's permission in Marsh's message scheduling apparatus, many users would refuse permission. Remember that Marsh depends on data categories such as ad statistics for scheduling and billing. In those cases where users refused permission to send the audit data categories, ad downloading could not be scheduled for such users. Further, fewer reports would result in vendors being under-billed. Accordingly, there is no reasonable expectation of success in modifying Marsh as proposed in the Office Action.

Further, even if Marsh were modified to incorporate Montague's authorization action, the result would omit "a send audit data display window that requests the user's permission to transmit each category of the audit data to the prescribed server system". This element is described in the specification and illustrated in FIG. 18A of this application. No such element is taught or suggested in Marsh. Montague only describes the ability of a user to "selectively authorize transmission of various data 174, 176 to and from a vendor base". See Montague at column 9, lines 22, 23. However, Montague specifies no means or mode for giving such authorization.

Note that asking for a user's permission to send audit data categories is not simply another advantage that flows directly from an element already in the prior art. That is to say, the "audit display window that requests the user's permission to transmit the ad-related statistical data to the specified server system" is not in the prior art and is an element that Marsh and Montague both lack. Montague at column 9, lines 20-25 teaches an executable 174 and output data 176 without specifying what the executable does or what the output data is. There is simply no teaching in Marsh or Montague of any "audit display window".

Accordingly, no *prima facie* case of obviousness has been established. See MPEP 2143 *et seq.*

With respect to claims 2 and 3, “the audit data is maintained as a log that is rotated at prescribed rollover intervals” wherein “the prescribed rollover intervals correspond to the prescribed audit intervals.” Marsh at column 3, lines 12-27 describes an advertisement distribution scheduler that apparently transmits “member profile information” to a database management system. However, this scheduler is a “server system” function, not a function of “software for use on a client device.” Marsh at column 7, lines 7-24 teaches recording statistical data related to advertisement display. This is not the “member profile data” which the advertisement distribution scheduler sends to a database management system. There are no “intervals” of any kind described in either of these passages. If “intervals” are considered to be inherent in either of these passages, the applicants respectfully request citation of a reference to establish such inherency.

With respect to claims 4-6, Marsh lacks a “prescribed server system” with “an audit manager function” that generates a “send audit data request” according to any “policy”. As to claim 4, the audit data transmit function in the “software for use on a client device” is activated by a “send audit transmit request” that is transmitted by the prescribed server system. Claims 5 and 6 specify that the prescribed server system has an “auditing manager function” that generates the “send audit data request in accordance with a client auditing policy”. The contention in the Office Action is that “Marsh teaches a client policy...”. In fact, Marsh at column 3, lines 12-27 describes an advertisement distribution scheduler that decides which ads are to be sent, and to whom, based on user profile information. At column 7, lines 7-22, Marsh describes the processing of a client system in displaying advertising. Neither passage of Marsh describes or suggests any manager in a server that activates an audit data transmit function, or that generates audit requests “in accordance with a client auditing policy”. In fact, Marsh does not describe or suggest a “send audit transmit request”, a “prescribed server system” with “an audit manager function” or any “client auditing policy” in either of these passages. Accordingly, the applicants respectfully request citation of a reference or entry of an affidavit to support this contention. See MPEP 2144.03.

Claims 7-17 are dependent from claim 1 and are patentably distinguishable from Marsh for reasons given above.

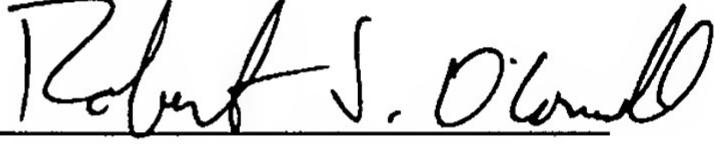
With respect to claims 18 and 19, the software of claim 1 is further limited by the audit data transmit function being activated “randomly” or “at random times”. Official Notice is taken that “it is old and well known to perform a function at random in order to

protect the data has been transmitted." Perhaps this is so in the computer arts generally; however, claim 18 is not directed to general data problems. Instead, the claim is directed to activation of an audit data transmit function. It is respectfully submitted that this limitation of the audit data transmit function is not and cannot be of such notorious character as to merit Official Notice. Accordingly, the applicants respectfully request citation of a reference or entry of an affidavit to support this statement. See MPEP 2144.03.

Therefore, in view of the failure of the art of record in this application to teach or suggest the entire invention recited in claims 1-19, it is submitted that these claims recite subject matter that is both novel and unobvious.

Respectfully submitted,

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